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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,375	09/08/2003	Hiroki Kishi	03500.017558.	8246
5514 7590 11/13/2009 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER SHAH, PARAS D				
ART UNIT		PAPER NUMBER		
2626				
MAIL DATE		DELIVERY MODE		
11/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/656,375

**Applicant(s)**

KISHI, HIROKI

**Examiner**

PARAS SHAH

**Art Unit**

2626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/07/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.6-10 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.6-10 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the Amendments and Arguments filed on 07/07/2009. Claims 1, 6-10, and 15-22 remain pending and have been examined. The Applicants' amendment and remarks have been carefully considered, but they are moot in view of new grounds for rejection. Accordingly, this action has been made FINAL.

All previous objections and rejections directed to the Applicant's disclosure and claims not discussed in this Office Action have been withdrawn by the Examiner.

### ***Response to Arguments***

2. Applicant's arguments (pages 7-8) filed on 07/07/2009) with regard to claims 1, 6-10, and 15-22 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the independent 1 and 10, rejected under 35 USC 101, the Applicant asserts that claim 1, is an apparatus claim and the encoding units and control unit is a concrete and tangible item. The Examiner respectfully disagrees with this assertion. There is no element in the claims that would reasonably convey that the apparatus claim was NOT software as stated in a preferred embodiment, paragraphs [0139] and [0140], where the Published Specification of the Applicant specifically describes the present invention is "not confined to only the apparatus and method" and further describes the "software-related programs themselves actualize the functions of the embodiments." Therefore, the specific units performing the functions are all software entities as described in the paragraphs above. Hence, the stated functions comprise

software and is thus not directed to a hardware embodiment. Furthermore, data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. Hence, for these reasons the Applicant's arguments are not persuasive and the rejection is maintained.

### ***Response to Amendment***

3. Applicants' amendments filed on 07/07/2009 have been fully considered. The newly amended limitations in claims 1 and 10 necessitate new grounds of rejection. Please see the new rejection under the 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> headings.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation of "audio encoding control unit" is not described in such a way the Applicant had possession of the claimed invention. The closest support can be found in paragraphs [0123] and [0127], which

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describes the operation of the audio data encoding unit 2801 that contains plural encoders 2902 and 2903. Specifically, a particular encoding unit is selected based on optimal coded audio data. In this section there is no mention of a control unit and how this control unit acts in a capacity to be the same as the audio data encoding unit. It is further not known whether this control unit is a physical entity or acts as a sub-routine as part of a software application. The Applicant is advised to show where in the Specification such a control unit is supported in order for the rejection to be withdrawn.

6. Claims 6-9 and 15-22 are rejected for being dependent upon a rejected base claim.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Claims 1 and 10, in paragraphs 6 and 5, respectively recite the audio encoding control unit that controls encoding in two particular cases. One of which the image setting unit effects the encoding and the other which does not. Furthermore, the data integration step in the next paragraph of the claims fail to realize that two specific cases and omits the data integration of the encoded audio and image data when the image encoding setting unit is not set for a particular region. Only integration is performed for the case where the image encoding setting unit effects the setting of the encoding. The omission of the former case leads to

a gap between the steps and is unclear what happens to the data when no setting for the particular regions occurs.

9. Claims 6-9 and 15-22 are rejected for being dependent upon a rejected base claim.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6-9, and 21 are rejected under 35 U.S.C. 101 because the claims appear to be directed to a software embodiment and not to hardware embodiment, where a machine claim is directed towards a system, apparatus, or arrangement. The claim appears to be directed towards a software embodiment. Paragraphs [0139] and [0140] describe the software program codes actualizing the embodiments of the invention. The claimed limitations are capable of being performed as software as described in the above paragraphs, alone since no hardware component is being claimed. Hence, the stated functions comprise software and is thus not directed to a hardware embodiment. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See e.g., *Warmerdam*, 33 F.3d at 1361, 31, USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between data and other claimed aspects of the invention, which permit the data

structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

***Allowable Subject Matter***

11. Claims 1 and 10 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 1<sup>st</sup>, 2nd paragraph, and 35 USC 101 set forth in this Office action.

12. The following is a statement of reasons for the indication of allowable subject matter: None of the cited references either alone or in combination thereof teach the limitation of the combination of "in accordance with said image encoding setting unit setting the encoding to make the partial region in each of frame images the high image quality, such that (1) the audio data is encoded by said first audio encoding unit to provide audio encoded data irrespective of whether said image encoding setting unit effects the setting of the encoding, *and (2) the audio data is encoded by each of said first audio encoding unit and said second audio encoding unit in a time period corresponding to the encoding set by said image encoding setting unit so that one of the respective audio encoded data provided by said first audio encoding unit and said second audio encoding unit is selected during the time period*" and the data integration unit and step as recited in the following paragraph of independent claims 1 and 10.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takahashi (US 6,173,265) and Gao et al. (US 6,604,070) is cited to disclose multiple rate encoders and selection based on a particular frame. Koshida et al. Sodagar et al. (US 6,526,175) is cited to disclose packetization significance information using multiple audio coders. (US 6,658,383) is cited to disclose speech and music coding. Blust (US 6,718,183) is cited to disclose vocoder selection. Shlomot et al. (US 7,080,010) is cited to disclose encoders being selected based on signal type.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARAS SHAH whose telephone number is (571)270-1650. The examiner can normally be reached on MON.-THURS. 7:30a.m.-4:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (571)272-7843843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/  
Supervisory Patent Examiner, Art Unit 2626

/Paras Shah/  
Examiner, Art Unit 2626

11/06/2009